

depending from claim 10 (which depends from claim 1) to change "a part of the 3-dimensional form data" to "the form of the part of the 3-dimensional form data". The current office action now rejects previously allowed claims 21-25 and 37-38 and previously objected to claims <sup>10</sup>1-12 and 15-18.

M.P.E.P. § 706.04 states that "A claim noted as allowable shall thereafter be rejected only after the proposed rejection has been submitted to the primary examiner for consideration of all the facts and the approval of the proposed action." The signature of the Examiner on the present office action does not denote his authority as a primary examiner. Consequently, the present record is devoid of any indication that a primary examiner considered all the facts and approved the proposed action. Furthermore, the Examiner did not point out in this office action that previously allowed claims were now being rejected, as specified in M.P.E.P. § 706.04.

The current act of rejecting these previously allowed and objected to claims without indication that a primary examiner considered all the facts and approved the action (of rejecting previously allowed claims) is even more egregious given the fact that Munetsugu et al. was used to reject claims 1-8 and 10-13 in the office action of May 8, 2002, the Amendment dated August 8, 2002, amended claims 1, 6, 9, 14, 26, 27 and 32, added new claims 36-39 and set forth arguments why the amended independent claims were patentable over Munetsugu et al., and the office action of November 6, 2001 indicated that claims 21-31 and 36-38 were allowed, claims 10-12 and 15-18 were objected to, and Munetsugu et al. was not used to reject claims 1-9, 13, 14, 19, 20, 34, 35 and 39.

Finally, the Examiner does not provide any (detailed) explanation as to why claims 1-12, 15-18, 21-25 and 37-38, previously considered to be allowable over Munetsugu et al., are now

→ different r.f.

considered to be obvious over this reference. Such action by the Examiner is clearly a reopening of prosecution on settled issues of record, without a clear explanation, on this record, as to why such action is being taken.

**In view of the above, it is respectfully requested that the Examiner either indicate that he signed the previous office action in the capacity of a primary examiner, or that a primary examiner now indicate that he considered all the facts and approved the rejection of claims 1-12, 15-18, 21-25 and 37-38, previously considered to be allowable over Munetsugu et al.**

#### **REJECTION OF CLAIMS UNDER 35 U.S.C. § 103**

Claims 1-8 and 10-13, and presumably claims 14-25, 29-31, 34, 35 and 37-39 also, are rejected under 35 U.S.C. § 103(a) as being unpatentable over Munetsugu et al. (hereinafter, Munetsugu). The Examiner notes as to claim 1, Munetsugu did not explicitly disclose “3-dimensional form data and 2-dimensional image data”, but contends that “it is well known that the model of the face is 3-dimensional and image of the face is in 2 dimensions.”

Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Munetsugu in view of Applicants’ admitted prior art.

The rejections are respectfully traversed.

The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Examiner. *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 223 USPQ 785 (Fed. Cir. 1984). In rejecting a claim under 35 U.S.C. §103, the Examiner must provide a factual basis to support the obviousness conclusion. *In re Warner*, 379 F.2d 1011, 154 USPQ 173 (CCPA 1967); *In re Lunsford*, 357 F.2d 385, 148

USPQ 721 (CCPA 1966); *In re Freed*, 425 F.2d 785, 165 USPQ 570 (CCPA 1970). Based upon the objective evidence of record, the Examiner is required to make the factual inquiries mandated by *Graham v. John Deere Co.*, 86 S.Ct. 684, 383 U.S. 117, 148 USPQ 459, 469 (1966). The Examiner is also required to explain how and why one having ordinary skill in the art would have been led to modify an applied reference and/or to combine applied references to arrive at the claimed invention. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Claim 1 recites, *inter alia*:

a modifying unit which *modifies a form of a part of the inputted 3-dimensional form data with maintaining a form of other parts thereof* based on 2-dimensional image data of the object.

The remaining independent claims require similar modification.

Applicants contend that the Examiner the Examiner did not establish a *prima facie* basis to deny patentability of the claimed invention under 35 U.S.C. § 103 for want of the requisite factual basis and lack of the requisite realistic motivation. Specifically, in rejecting a claim under 35 U.S.C. § 103, the Examiner is required to identify a source in the applied prior art for: (1) every claim limitation; and (2) the requisite motivation for combining applied references with a reasonable expectation of achieving a particular benefit. *Smith Industries Medical Systems v. Vital Signs*, 183 F.3d 1347, 51 USPQ2d 1415 (Fed. Cir. 1999). That burden has **not** been discharged.

As noted in the response dated August 8, 2001, in *Munetsugu*, a size of a hair image is merely adjusted to a size of a face information model. In other words, the face information model, as 3-dimensional form data, is only enlarged and reduced in its **entirety**. Therefore, just a part of the face information model cannot be modified with respect to other parts thereof.

The Examiner's statement that "it is well known that the model of the face is 3-dimensional and image of the face is in 2 dimensions" does not fulfill his burden of establishing a *prima facie* basis to deny patentability to the claimed invention. More specifically, while Applicants do not gain say that it may be well known that the model of the face is 3-dimensional and image of the face is in 2 dimensions, such assertion by the Examiner fails to establish the requisite motivation to modify the arrangement of Munetsugu to result in modifying a form of a part of inputted 3-dimensional form data with maintaining a form of other parts thereof based on 2-dimensional image data of the object.

As to claim 3, Munetsugu discloses (column 5, lines 29-38) that a hair removed image 16 is generated by specifying removal region 15 from a front face image 23 (2-dimensional image) and modifying the front face image 13. However, any modification of 3-dimensional data is not disclosed in this description of Munetsugu. More specifically, it is merely explained that a face surface model 14 is used in order to determine the removal region 15. In Munetsugu, except for description of Fig. 13, nothing discloses or suggests *modification of 3-dimensional form data*.

As to claim 9 certainly, Applicants describe "a known graphic technique such as providing with a shade is used to make a good show" at page 17 of the present specification. However, the description does not give any influence to patentability as to claim 9.

More specifically, what is described at page 17 of the present specification is a display of a 3-dimensional form model, and the description has no relation with area division from a 2-dimensional image. In other words, Applicants fail to disclose that area division is carried out with respect to a shade portion of an object at page 17 of the present specification. Accordingly, Applicants (AAPA) do not teach nor suggest that area division with respect to the shade portion of the object is "a known technique" at page 17 of the present specification.

Even if area division with respect to the shade portion of the object is known, it is not known that the area division is carried out with reference to image data of a surrounding portion. Area division with respect to the shade portion of the object is not referred to at page 17 of the present specification at all; i.e., Applicants do not mention that it is known.

Thus, claims 1-8, and 10-13, and presumably claims 14-25, 29-31, 34, 35 and 37-39, are patentable over Munetsugu, and claim 9 is patentable over Munetsugu even when considered in view of Applicants' admitted prior art.

Consequently, the allowance of claims 1-14-25, 29-31, 34, 35 and 37-39 is respectfully solicited.


#### **CONCLUSION**

Accordingly, it is urged that the application, as now amended, is in condition for allowance, an indication of which is respectfully solicited. If there are any outstanding issues that might be resolved by an interview or an Examiner's amendment, Examiner is requested to call Applicants' attorney at the telephone number shown below.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT, WILL & EMERY



Edward J. Wise  
Registration No. 34,523

600 13<sup>th</sup> Street, N.W.  
Washington, DC 20005-3096  
(202) 756-8000 EJW:khh  
**Date: January 23, 2003**  
Facsimile: (202) 756-8087